

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 59300CIP(71970)	
	Application Number 10/806,834-Conf. #4234	Filed March 22, 2004	
	First Named Inventor Dong-Yeon Kim et al.		
	Art Unit 1616	Examiner A. N. Pryor	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <div style="display: flex; justify-content: space-between; align-items: flex-start;"> <div style="width: 60%;"> <p><input type="checkbox"/> applicant /inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>51,615</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____</p> </div> <div style="width: 35%; text-align: center;"> <p>_____ /Nicholas J. DiCeglie, Jr./ Signature</p> <p>_____ Nicholas J. DiCeglie, Jr. Typed or printed name</p> <p>_____ (212) 308-4411 Telephone number</p> <p>_____ January 30, 2009 Date</p> </div> </div> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			
<input type="checkbox"/> *Total of <u>1</u> forms are submitted.			

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Dong-Yeon Kim et al.

Application No.: 10/806,834

Confirmation No.: 4234

Filed: March 22, 2004

Art Unit: 1616

For: N-PHENYL-2-PYRIMIDINE-AMINE
DERIVATIVES AND PROCESS FOR THE
PREPARATION THEREOF

Examiner: A. N. Pryor

**REMARKS/ARGUMENTS IN SUPPORT OF
PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicants are in receipt of the final Office Action dated November 18, 2008 (the "Office Action"), and now request review of the Office Action. A Notice of Appeal is filed herewith. The following remarks support Applicants' "Pre-Appeal Brief Request for Review" filed herewith. These remarks do not exceed five pages, do not present amendments, and are being filed with a Notice of Appeal, thereby satisfying the requirements for review.

The Office Action

In the Office Action, Claims 1-4 and 6-8 were rejected under 35 U.S.C. §112 as allegedly lacking support for the following definitions in the original specification:

1. R4 = H and two of R5, R6 and R8 being halogen, lower alkyl, or lower alkoxy; and
2. R4 = H and one or two of R5, R6 and R8 being alkoxy.

The Examiner alleges that these items are new matter added to the specification.

Clear Error and/or Omission in the Final Office Action:The 35 U.S.C. §112 rejection had previously been made and overcome

In the Office action dated July 28, 2006, the Examiner rejected claims 1-4 and 6-8 under 35 U.S.C. §112, stating that "R4 = H and one or two of R5, R6, and R8 each... or a lower alkoxy is new matter." The Examiner goes on to state "The specification supports one or two of R4, R5, R6 and R8 each represent halogen ... or lower alkoxy."

In a response dated October 26, 2006, Applicants drew the Examiner's attention to Examples 5 to 8 and Examples 24 and 28 as supporting compounds "wherein R4 = H and one or two of R5, R6, and R8 each represent halogen, lower alkyl, or lower alkoxy."

The rejections under 35 U.S.C. §112 were maintained in the subsequent Final Office Action dated January 29, 2007. In a response dated April 4, 2007, Applicants again directed the Examiner's attention to Examples 5-8 and 24 and 28, by drawing out the specific structures described. A supplemental amendment was submitted on April 25, 2007 to remove a duplicate definition for R9 and to conform the claim language of Claim 2 with Claim 1.

In an advisory action dated May 3, 2007, the Examiner stated that such amendments would raise new issues which would require further consideration or a new search.

On May 25, 2007, following an interview with the Examiner, Applicants filed a response to Final Office Action and Advisory Action which attempted to clarify the claim language with regard to the definition of R9 and re-presenting the support arguments with the structures drawn from Examples 5-8, 24 and 28.

On July 27, 2007, Applicants filed a Request for Continued Examination requesting entry of the amendments filed in the May 25, 2007 response and consideration of the arguments presented therein.

In the Office Action dated October 10, 2007, Claims 1, 2 and 6-8 were rejected under 35 U.S.C. §103 and claims 3 and 4 were objected to as dependent on a rejected base claims but otherwise allowable. No other rejections were discussed. In the Office Action, the Examiner stated that "previous rejections not discussed below ***have been withdrawn*** in light of Applicants' submissions..." (emphasis added).

As the Final Office Action merely reiterates the rejection of the July 28, 2006 Office Action which the Examiner withdrew in the October 10, 2007, and in light of Applicants' prior submissions of exemplary support for the claims, Applicants respectfully submit that the present claims are fully compliant with the requirements of 35 U.S.C. §112 and that such compliance was previously acknowledged by the Examiner.

CONCLUSION

For at least the foregoing reason, Applicants contend that the rejections of record should be withdrawn, and that the present application is in condition for allowance. Early and favorable consideration of the application is earnestly solicited.

The Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 04-1105, under Order No. 59300CIP (71970).

Dated: January 30, 2009

Respectfully submitted,

Electronic Signature:

/Nicholas J. DiCeglie, Jr./

Nicholas J. DiCeglie, Jr.

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